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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,610	09/12/2003	Volker Labach	35185/41485	6108

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BARNES & THORNBURG  
750-17TH STREET NW  
SUITE 900  
WASHINGTON, DC 20006

EXAMINER

MILLER, JONATHAN R

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/660,610	LABACH, VOLKER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jonathan R. Miller	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20030912</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

**DETAILED ACTION**

***Information Disclosure Statement***

1. The information disclosure statement filed 9/12/03 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 has the language: "wherein two plates, forming a chamber, rest on two surfaces of the ring." What does it mean to "rest on"? Is there contact? Does the ring support the plates? This language renders the claims indefinite.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-5 and 7 – 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Mori et al. The reference discloses a separating device (11) arranged on an output side of the storage container (10); an aligning station (31) adjoining the separating device, the aligning station precisely positioning each small part in a heads up orientation to be transferred; and a transfer device (72), connected with the aligning station, transferring each small part to a processing unit.

6. With regards to claim 2, the reference further discloses the separating device includes a ring (11) whose interior surface area has pockets embedded in a radial direction, and which ring can be rotated by a drive (M) applied to an exterior surface area of the ring (Fig. 3), the ring rotating about a horizontal axis (12).

7. With regards to claim 3, the reference further discloses two plates (11a, 10a), forming a chamber, rest on two surfaces of the ring (Fig. 1).

8. With regards to claim 4, the reference further discloses the ring can be rotated in a timed manner (col. 11, lines 50+).

9. With regards to claim 5, the reference further discloses the aligning station is arranged directly below one of the pockets, which pocket is in a respective timed position, and the chamber is positioned below the aligning station (Figs. 1 and 3).

10. With regards to claim 7, the reference further discloses the timed manner can be controlled by a second sensor (col. 8, lines 44+).

11. With regards to claim 8, the reference further discloses the ring can be driven by way of driving rollers (18) resting against an exterior surface area of the ring (Fig. 3).

12. With regards to claim 9, the reference further discloses the aligning station includes two cheeks between which a longitudinal slot is formed whose upper lateral edge areas each form a

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support for a head of the small part, and a width of the slot being larger than a shaft diameter of the small part but smaller than the head's diameter of the small part (Fig. 21).

13. With regards to claim 10, the reference further discloses the supports are constructed as an inclined plane which slopes from the ring toward an outside area of the aligning station (Figs. 1 and 21).

14. With regards to claim 11, the reference further discloses the aligning station includes a pneumatically operated driving device (47) by which a small part, resting on the supports, can be pushed into a feeding shaft which leads into the transfer device (col. 12, lines 1+).

15. Claims 1, 2, 4, 6, 7 and 9 – 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Goodrich et al. The reference discloses a separating device (30) arranged on an output side of the storage container; an aligning station (40) adjoining the separating device, the aligning station precisely positioning each small part in a heads up orientation to be transferred; and a transfer device (95), connected with the aligning station, transferring each small part to a processing unit.

16. With regards to claim 2, the reference further discloses the separating device includes a ring (30) whose interior surface area has pockets (32) embedded in a radial direction, and which ring can be rotated by a drive applied to an exterior surface area of the ring, the ring rotating about a horizontal axis (Fig. 1). Examiner contends that the language “can be rotated by a drive applied to an exterior surface area of the ring” is not afforded patentable weight.

17. With regards to claim 4, the reference further discloses the ring can be rotated in a timed manner (col. 6, lines 45+).

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18. With regards to claim 6, the reference further discloses a first sensor, which is stationary with respect to the rotatable ring, is provided, the first sensor indicating whether a small part occupies one of the pockets (col. 11, lines 32+).

19. With regards to claim 7, the reference further discloses the timed manner can be controlled by a second sensor (col. 11, lines 32+).

20. With regards to claim 9, the reference further discloses the aligning station includes two cheeks between which a longitudinal slot is formed whose upper lateral edge areas each form a support for a head of the small part, and a width of the slot being larger than a shaft diameter of the small part but smaller than the head's diameter of the small part (Fig. 5).

21. With regards to claim 10, the reference further discloses the supports are constructed as an inclined plane which slopes from the ring toward an outside area of the aligning station (Fig. 1).

22. With regards to claim 11, the reference further discloses the aligning station includes a pneumatically operated driving device by which a small part, resting on the supports, can be pushed into a feeding shaft which leads into the transfer device (col. 10, lines 28+).

23. Claims 1 - 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Spraker. The reference discloses a separating device (10) arranged on an output side of the storage container (13); an aligning station (25) adjoining the separating device, the aligning station precisely positioning each small part in a heads up orientation to be transferred; and a transfer device (32), connected with the aligning station, transferring each small part to a processing unit.

24. With regards to claim 2, the reference further discloses the separating device includes a ring (19) whose interior surface area has pockets (20) embedded in a radial direction, and which

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ring can be rotated by a drive applied to an exterior surface area of the ring (col. 3, lines 30+), the ring rotating about a horizontal axis (22). Examiner contends that the language “can be rotated by a drive applied to an exterior surface area of the ring” is not afforded patentable weight.

25. With regards to claim 3, the reference further discloses two plates (11, 16), forming a chamber, rest on two surfaces of the ring.

26. With regards to claim 4, the reference further discloses the ring can be rotated in a timed manner (col. 4, lines 38+).

27. With regards to claim 7, the reference further discloses the timed manner can be controlled by a second sensor (31; col. 4, lines 38+).

#### *Conclusion*

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan R. Miller whose telephone number is (571) 272-6940. The examiner can normally be reached on M-F: 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy A. Matecki can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jrm

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